

~~15.~~ The method of claim 4, wherein said recombinant DNA molecule defined in step (a)(i) further comprises a terminator sequence which defines a termination signal during transcription of the DNA sequence described in step (a)(i)A.

16. The method of claim 4, wherein said recombinant DNA molecule defined in step (c)(i) further comprises a terminator sequence which defines a termination signal during transcription of the DNA sequence described in step (c)(i)A.--

### REMARKS

Applicants acknowledge the Examiner's statements that "[c]laims 5-7 are allowed" and "[c]laims 1 and 3-7, and newly submitted claims 9-11 are deemed free of the prior art." Paper No. 14 at page 3. Applicants' addition of proposed new claims 12-16 and Applicants' proposed amendments to the claims are fully supported by the present specification and are not made in acquiescence to any rejection. Proposed new claim 12 is discussed in detail below. Proposed new dependent claims 13-16 define terminator sequences for the recombinant DNA sequences recited the independent claims. These amendments, therefore, does not disclaim any subject matter to which Applicants would be entitled. *Cf. Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 41 USPQ2d 1865 (U.S. 1997). In any event, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections in view of the following remarks.

### **Rejection Under 35 USC § 112, Second Paragraph**

The Examiner rejected claims 3-4 under 35 USC § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Specifically, the Examiner argues that the recitation in claim 3 "part (a), lines 1-2 of 'said pollen producing plant' which lacks antecedent basis in the amended claim." The Examiner also argues that the recitation in claim 4 "part (e), line 1 of 'optionally' which contradicts the preamble of the claim, drawn to a method of producing hybrid seeds (emphasis added)."

Without acquiescing to the rejections, and solely to expedite prosecution of the present application and to place it in condition for allowance, Applicants proposed amendment to claim 3, as well as to claim 4, correct the antecedent basis for the recited plant. Applicants' other proposed amendment to claim 4 deletes the optional "effecting a hybrid cross" step from independent claim 4. Applicants submit that deleted step as new proposed dependent claim 12. These amendments do not disclaim any subject matter to which Applicants would be entitled. *See Warner-Jenkinson, supra.* Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejection.

#### **Rejection Under 35 USC § 112, First Paragraph**

The Examiner rejected claims 1, 3-4, and 9-11 under 35 USC § 112, first paragraph, arguing that "because the specification, while being enabling for claims limited to the introduction of sense genes conferring resistance to antibiotics or herbicides, does not reasonably provide enablement for claims encompassing any gene conferring resistance to any other chemical stress or any physiological stress." Specifically, the Examiner argues that the "specification does not enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to make/and or use the invention commensurate in scope with these claims. . ." Applicants' respectfully traverse.

Again addressing the Examiner's statements regarding the alleged lack of examples in Applicants' specification regarding genes conferring resistance to chemical or physiological stresses, Applicants respectfully submit that a patent specification is presumed to be enabling and the PTO has the burden of establishing a *prima facie* case of lack of enablement. *See, e.g., In re Angstadt*, 190 USPQ 214, 219 (CCPA 1976); *In re Marzocchi*, 169 USPQ 367, 369-70 (CCPA 1971). To make a *prima facie* case of lack of enablement, the PTO must come forward with reasons, supported by the record as a whole, showing why the specification fails to enable one of ordinary skill in the art to make and use the claimed invention. *In re Angstadt*, 190 USPQ at 219. Moreover, the Examiner's alleged "scientific reasoning and evidence in the form of literature citations" fail to acknowledge the fact that one skilled in the art could make and use the claimed invention. The mere fact that some

experimentation is necessary does not negate enablement so long as undue experimentation is not required. MPEP § 608.01(p). The burden is on the PTO to establish that experimentation would be undue, *Angstadt*, 190 USPQ at 219, taking into consideration the eight factors that are to be considered in determining whether a disclosure requires undue experimentation. *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Applicants respectfully direct the Examiner's attention to *In re Wright*, 27 USPQ2d 1510 (Fed. Cir. 1993), in which the Federal Circuit made it clear that §112 requires objective enablement and therefore, it is irrelevant whether the teachings of the specification are provided through broad terminology or illustrative examples. Moreover, the Federal Circuit's position is consistent with the CCPA's earlier determination that a patent specification need not contain a single working example. *In re Bundy*, 209 USPQ 48 (CCPA 1981). *See also Ex parte Nardi*, 229 USPQ 79 (BPAI 1986) (the fact that the specification is devoid of working examples is without significance).

Applicants' specification provides that which is required by the extant law: teachings through the use of broad terminology in conjunction with examples which demonstrate the use of the methodology of the present invention. Although Applicants' specification contains no specific working examples relating to genes conferring resistance to chemical or physiological stresses, Applicants respectfully submit that such examples are not required, nor needed, for one skilled in the art to make and use the claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejection.

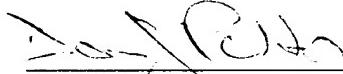
Applicants respectfully submit that the foregoing represents a complete response to the outstanding Final Office Action and that the application is in condition for allowance. Reconsideration and an early indication of allowability are thus respectfully requested. Should the Examiner feel that any other point requires consideration or discussion, he is invited to contact the undersigned at (202) 672-5519.

If there are any fees due in connection with the filing of this Amendment, please charge the fees to our deposit account No. 19-0741. If a fee is required for an extension of time not accounted for, such an extension is hereby requested and the fee should also be charged to our deposit account.

Respectfully submitted,

May 15, 1997

Date

  
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